

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Stuart A. Fraser et al.
Application No. : 10/829,119 Confirmation No. : 6481
Filed : April 20, 2004
For : SYSTEMS AND METHODS FOR TRADING
Group Art Unit : 3692
Examiner : Ann E. Loftus

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the Final Rejection of June 18, 2008 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

REMARKS

For the following reasons, Applicants request review of the Final Rejection of June 18, 2008 in the present application.

I. THE EXAMINER FAILS TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS OF ANY OF THE CLAIMS

To reject claims under 35 U.S.C. § 103, an examiner must show an unrebutted *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974).

The Examiner fails to show that the cited portions of Wiseman, U.S. Patent No. 5,168,446 (hereinafter Wiseman), and Vojtech Menzl, “Czech Republic - Environmental Protection Equipment” (hereinafter Menzl), teach or suggest all the limitations of independent claims **38**, **58**, and **67** and as such, fails to establish a *prima facie* case obviousness of these claims, and the claims that depend there from.

Specifically, at pages 4-6 of the Office Action, the Examiner rejects independent claims **38**, **58**, and **67** under 35 U.S.C. § 103(a) as being unpatentable over Wiseman in view of Menzl. Claims **38**, **58**, and **67** recite in part:

make the order available to at least a second participant for at least a predetermined period of time such that the second participant has the ability to trade against the order during at least the predetermined period of time;

In rejecting claims **38**, **58**, and **67** regarding these limitations, the Examiner asserts in part:

Wiseman does **not** explicitly address making the order available during at least the predetermined period of time. Menzl teaches in section 5.4.1, a time period during which bidders are bound with their offers. A person of ordinary skill in the art would understand this to mean that if their offer is accepted during this time, they must honor it. It is implicit that accepting the offer to make a deal is possible during this time **and that it is not possible for the bidder to cancel during this time.**

Office Action, page 5 (bold emphasis added).

In other words, the Examiner interprets Menzl Section 5.4.1 to disclose “that it is not possible for the bidder to cancel during this time” and based on this interpretation of Menzl,

asserts that the above noted limitations of claims **38, 58, and 67** are taught or suggested by Wiseman and Menzl.

However, the teachings of Menzl are in contrast to and do not support the Examiner's interpretation of Section 5.4.1 and as such, the Examiner fails to establish a *prima facie* case of obviousness. Specifically, in rejecting claims **38, 58, and 67**, the Examiner appears to rely on the following portion of Menzl Section 5.4.1:

- Evaluation time, defined as a time period during which bidders are bound with their offers, is uniform for all participants and may not exceed 90 calendar days. This does not apply for the first three bidders, whose evaluation period is extended until the contract is signed.

Menzl, page 10.

However, Menzl Appendix A provides more details to Section 5.4.1. Specifically, Appendix A includes the above paragraph at page 25 as "Article 8" and further states in part:

Guarantee is forfeited if an applicant, in contradiction to this Act or the tender conditions, **canceled** or changed **his bid** or did not meet the obligation to sign the contract **during the standard or extended evaluation time**. (Article 26)

Menzl, page 27 (bold emphasis added)

In other words, Menzl Article 26 discloses that a bid may be canceled during the evaluation time, which is in contrast to the Examiner's assertion "that it is not possible for the bidder to cancel during this time."

Because the teachings of Menzl are in contrast to and do not support the Examiner's rationale for rejecting claims **38, 58, and 67**, the Examiner fails to show that the cited portions of Wiseman and Menzl teach or suggest the above noted limitations of these claims. As such, the Examiner fails to establish a *prima facie* case of obviousness of claims **38, 58, and 67**, in addition to claims **41, 45-47, 50-54, 56-57, 59, 62-66, 68, and 71-75**, which depend therefrom.

II. THE EXAMINER'S RESPONSE TO APPLICANTS' ARGUMENT IS INACCURATE

Applicants presented the above arguments in Applicants' Amendment/Submission of April 21, 2008 (see at least pages 5-6). In response to Applicants' Amendment/Submission, the Examiner states in the present Office Action:

The applicant argues that it is not shown, and there is no evidence, that Menzl teaches ‘that it is not possible for the bidder to cancel during this time.’ The applicant argues that Menzl also teaches that some cancellations are possible. This language is not in the claim.

In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “that it is not possible for the bidder to cancel during this time”) are not recited in the rejected claim(s).

Office Action, page 2.

Contrary to the Examiner’s statements, Applicants are **not** arguing that language such as, “that it is not possible for the bidder to cancel during this time,” is recited by the claims. Rather, Applicants are **quoting** the Examiner’s interpretation of Menzl, and further noting that the Examiner’s interpretation is contrary to and not supported by Menzl, as discussed above.

III. CONCLUSION

Because the Examiner fails to establish a *prima facie* case of obviousness of any of the claims, withdrawal of the rejection is respectfully requested.

Respectfully submitted,

/Glen R. Farbanish/

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Date

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